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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,566	05/07/2001	Anton Negele	205892USOPCT	1079

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EXAMINER

REDDICK, MARIE L

ART UNIT PAPER NUMBER

1713

DATE MAILED: 10/01/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,566

Applicant(s)

NEGELE ET AL.

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/22/03 has been entered.

Claim Objections

2. Claim 10 is objected to because of the following informalities: In claim 10 @ line 5, "40 to 55 C" should read "40 to 55 degrees C". Appropriate correction is required.

Specification

3. The amendment filed 09/22/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The concentration of sodium dihydrogen phosphate dihydrate, based on water, provided for Runs 1-4 is not accompanied by any viable data to show how such data was arrived at, i.e., the standard for ascertaining the requisite amount of "stabilizing inorganic salt" permitted has not been provided on this record and, as such, this constitutes New Matter. Further, the page and line requested to have the amendment entered appears to be incorrect. It is believed that page 12, line 30 is the correct page and was intended.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The standard for ascertaining the requisite amount of "stabilizing inorganic salt" permitted has not been provided on this record and therefore, the claims(1-10) are not supported by the specification

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-7 stand rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fong et al(U.S. 6,426,383 B1) as per reasons clearly stated in the previous Office Action per paper no. 11, 04/22/03, paragraph no. 5.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 8-10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Fong et al (U.S. 6,426,383) in combination with Matsushima et al (U.S. 5,936,042) as per reasons clearly stated in the previous Office Action per paper no. 11, 04/22/03, paragraph no. 7.

Allowable Subject Matter

13. Claims 1-4 are deemed allowable over Fong et al (U.S. 6,426,383 B1) as per one having ordinary skill in the art would not have been endowed with any motivation to extrapolate an aqueous dispersion, substantially free of stabilizing inorganic salt, as claimed, from the disclosure of Fong et al who disclose aqueous dispersions containing inorganic salt(s) in amounts in excess of the claimed "substantially free" as interpreted by the data provided in the Amendment to the specification of paper no. 16, 09/22/03, with any reasonable expectation of success.

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Response to Arguments

14. Applicant's arguments, see paper no. 16, filed 09.22.03, with respect to the rejection of claims 1-4 under 35 USC 102(e)/103(a) over Fong et al (U.S. 6,426,383) have been fully considered and are persuasive. The rejection under 35 USC 102(e)/103(a) over Fong et al of claims 1-4 has been withdrawn. However, if the New Matter Objection is not obviated via viable evidence, then the Rejection of claims 1-4 based on Fong et al will be reinstated.

15. Applicant's arguments filed 09/22/03 have been fully considered but they are not persuasive.

Relative to Fong et al—The claims(5-10) are drawn to a process that requires that monomers comprising N-vinylformamide and/or N-vinylacetamide along with at least one polymeric dispersant be polymerized in water "substantially free of stabilizing inorganic salts", i.e., the claims do not require that the resultant aqueous dispersion be "substantially free of stabilizing inorganic salts. To this end, Fong et al @ col. 14, lines 25-27 clearly state that "in preparing the aqueous polymer dispersion, in accordance with the present invention, inorganic salts soluble in water may be required". Fong et al @ col. 14, lines 41-42 further state that "the inorganic salt may also be added after the polymerization process has ended". This clearly translates to 0 wt.% of the inorganic salt(s) is required during the polymerization process and meets the limitations per the claimed invention.

Relative to the Declaration under 37 CFR 1.132 filed on 08/06/03, the Declaration is insufficient to remove the rejections based on Fong et al(alone) or further in combination with Matsushima et al. While Counsel argues that the Declaration proves that the aqueous dispersions of Fong et al could not be formed without the presence of inorganic salt(s), the amount of salt used in the comparative Run appears to be very close to the upper limit of salt authorized by Fong et al. More specifically, Counsel has not shown that amounts as low as "about 5 wt.%" of salt, authorized by Fong et al, would result in the inability to form aqueous

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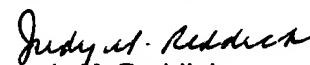
polymer dispersions. To this end, the Declaration under 37 CFR 1.132 is insufficient to confer patentability under 35 USC 102.


Relative to the Fong et al/Matsushima et al combination—In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is urged and maintained that Matsushima et al provides ample motivation to use at least the polyethyleneimine and/or polyethylene glycol as the dispersant(stabilizer) in the polymerization of N-vinylformamide and/or N-vinylacetamide per Fong et al and with a reasonable expectation of success.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.


Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR 
09.28.03